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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POLLICOFF, STEVEN B

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/504,826

Applicant(s)

BRUHN ET AL.

Examiner

Steven B. Pollicoff

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 8/16/04;10/25/04.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "strip patterns" as recited in claims 5-8, the "single-piece blank which is previously folded over onto itself" in claim 9, the "single-piece blank" in claim 12, the "seam formed with an at most three layered overlap" in claim 13, the "seam arranged adjacent to the end of the lid articulation" in claim 14, the "layers of different thicknesses" of claim 15, the "additional layer" between the two layers of paper in claim 17, and the "reinforced" swing-out tabs of claims 18 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 3728

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It should be noted that the following list is not exhaustive and Applicant should review and correct any other 112, second paragraph errors not mentioned below. With respect to claims 1 and 20, it is unclear what is included in the outer pack. Is the outer pack at least one blank plus two additional outer pack layers or is it a two layered blank or is it two blanks layered together? For purposes of examination Examiner will interpret the claims to mean that the outer pack is two blanks layered together. With respect to claims 1 and 20 there is a lack of antecedent basis for "the side-wall region" in line 3. With respect to claims 5-8, there is a lack of antecedent basis for "the adhesive" as there is no recitation of adhesive in claim 1. With respect to claim 10, it is unclear what applicant means by "in the first instance". Examiner will assume applicant intended that it mean a step of adhering the two blanks together? With respect to claim 14, there is a lack of antecedent basis for "the lid articulation". With respect to claim 15, it is unclear what applicant is referring to as having layers of different thicknesses. Examiner will assume it is the blank that can

Art Unit: 3728

have variable thicknesses. With respect to claim 17, there is a lack of antecedent basis for "the two layers of paper". With respect to claim 18, there is a lack of antecedent basis for "the inner layer" and "the hinged lid".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,10,13,14,18,19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoch et al., (WO99/02428;US 6,370,846).

With respect to claims 1 and 20, Schoch discloses a process for packaging cigarettes as a cigarette block and a cigarette pack comprising a cigarette block, possibly wrapped in inner paper, in an outer pack which is at least partially rounded and score-free in the side-wall region (Schoch Fig 11) and comprises at least one blank (Fig 7), two outer-pack layers (e.g. Fig 7 and 8 ref 4''' and 2'') which extend over the entire outer periphery of the side-wall region being arranged one above the other and connected to one another along a seam, and base-closure (Fig 8 ref 6 and 23), and, if appropriate, lid-closure flaps (Fig 7 ref 8 and 42) of the at least one blank being folded over and connected, wherein the two layers are connected to one another, over the entirety of the surface areas located opposite one another, at least in an essentially uniform connecting pattern such that stressing occurring in rounded wall regions is essentially avoided (see Fig 12-14B generally).

Art Unit: 3728

With respect to claim 2, Schoch discloses that the blank material can be cardboard (column 1, line 4).

With respect to claim 10, Schoch discloses that the outer pack is made of two blanks (Fig 7 and 8).

With respect to claim 13, Schoch discloses that the seam is formed with an at most three-layered overlap (Fig 14A). Inside part ref 2''' is being layered with casing ref 4. The seam here is twice layered and certainly within the limitation of being formed with at most three layered overlap.

With respect to claim 14, Schoch discloses that the seam is arranged adjacent to the end of the lid articulation (see Fig 10 the seam being the fold line between panels ref 16 and 14 and the lid articulation being the fold line at ref 37).

With respect to claims 18 and 19, Schoch discloses adhesively reinforced swing-out tabs (Fig 10 ref 41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3728

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoch et al., (WO99/02428; US 6,370,846).

With respect to claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive such as cold glue to connect the two layers, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin 125 USPQ 416.

With respect to claims 15 and 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use blanks of different thicknesses and weights of approximately 120-150 g/m² since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller 105 USPQ 233.

Claims 4, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoch et al., (WO99/02428; US 6,370,846) in view of Evers et al., (EP 0,545,723).

With respect to claim 4, Schoch does not expressly disclose that use is made of blanks with previously applied adhesive which can be activated by heat and/or pressure and/or ultrasound, this being done during the packaging operation. However, Evers discloses a rounded end cigarette box connecting an inner and outer sleeve member through heat or ultra sonic vibrations (Evers specification page 4, right hand column,

Art Unit: 3728

lines 28-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method step of adhering the two layers of Schoch to include adhering by heat and/or pressure and/or ultrasound during the packaging operation, as taught by Evers, for the purpose of providing more specific and alternative methods of connecting layers of paperboard.

With respect to claims 9, 11 and 12, Schoch does not expressly disclose that the outer pack is made of a single-piece blank which is previously folded onto itself, the resulting two layers being at least partially connected to one another in a region that is not bent. However, Evers discloses a single-piece blank (Evers Fig 4) having an outer and inner sleeve for folding on one another for forming a rounded end cigarette box. Therefore, it would have been obvious to one having ordinary skill in the art to modify the inside and casing parts to be made integral as one piece since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit* 150 US 164 (1893).

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoch et al., (WO99/02428; US 6,370,846) in view of Focke et al., (5,462,223).

With respect to claims 5-8, Schoch does not expressly disclose that the adhesive is applied in an at least partially interrupted stabilizing strip pattern. However, Focke discloses a blank being coated with adhesive in an interrupted stabilizing strip pattern (Fig 2 ref 29a-i, 30, 31, 32, 80, 81). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adhesive of Schoch such that it was applied in an interrupted stabilizing strip pattern, as taught by

Art Unit: 3728

Focke, for the purpose of sufficiently fixing complimentary folded portions of the blank into a closed hinge-lid pack (column 1, lines 30-34).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ABP 2/20/07
SBP


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